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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/981,696	10/16/2001	Eiji Kawai	09812.0174-00000	7316
22852	7590	03/03/2006		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER OUELLETTE, JONATHAN P	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 03/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/981,696

Applicant(s)

KAWAI, EIJI

Examiner

Jonathan Ouellette

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8-15, 19-22, 24-33 and 35-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-15, 19-22, 24-33 and 35-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Claims 7, 16-18, 23, and 34 have been cancelled; therefore, Claims 1-6, 8-15, 19-22, 24-33, and 35-40 are pending in application 09/981,696.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. **Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

4. Claim 1 discloses an information collecting apparatus, however, the apparatus described never completes any information collecting steps; rather, the apparatus erases information from the portable terminal and transmits data to the portable terminal.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) The invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international

application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. **Claims 1-6, 8-15, 19-22, 24-33, and 35-40 are rejected under 35 U.S.C. 102(e) as being anticipated by Treyz et al. (US 6,587,835 B1).**
7. As per **independent Claim 1**, Treyz discloses an electronic guide information processing system for electronically processing guide information about a customers attracting facility, the facility having at least one customer exit (inherent and lawfully required for all stores and amusement parks, Fig 10), comprising: an information distributing apparatus for converting the guide information into electronic guide information (store computer, data configuration for transmission), and then distributing the electronic guide information (transmitting data, Fig.2, Fig.13); a portable terminal apparatus for recording and reproducing the electronic guide information for an information user (Fig.13), and an information collecting apparatus for erasing the electronic guide information from the portable terminal apparatus at an exit of the facility (C49, shopping assistance link deleted along with icon/descriptive information – once user out of range or has exited the facility) and writing in the portable terminal apparatus at least one of information about use status of the customers attracting facility by the information user (C46 L9-42, Financial transaction information sent to user; C63 L13-20, download personal postcard) and advertisement information about the customers attracting facility (C47-C48, targeted advertising; C51 L18-26, advertisements received at checkout), wherein the portable terminal apparatus presents the electronic guide information to the information user (Figs.1, 2, 37, 42; C13, data transmission; C34-37).

8. As per Claim 2, Treyz discloses wherein the electronic guide information is distributed to the portable terminal apparatus by use of an already-existing broadcasting infrastructure or/and a communication infrastructure (RF, IR, Bluetooth transmission infrastructure).
9. As per Claim 3, Treyz discloses wherein an information-recording medium is mounted to the portable terminal apparatus, and wherein the electronic guide information about the customers attracting facility is recorded in the information-recording medium (C35 L10-20, removable storage media).
10. As per Claim 4, Treyz discloses wherein the information recording mediums is provided by use of an already-existing sales infrastructure (C35 L10-20, store provides removable storage media).
11. As per **independent Claim 5**, Treyz discloses an electronic guide information processing system for processing electronic guide information about a customers attracting facility which restricts the customers to go in and out only through its entrance and exit (common amusement park customer ticketing/access control, Treyz discloses ticketing elements), comprising: an information lending apparatus for lending the electronic guide information, to an information user (Kiosk, C22 L43-54; or Transmission of electronic guide information once user is within range, C22 L16-42); a portable terminal apparatus for recording and reproducing the electronic guide information which has been lent from the information lending apparatus (Fig.13, Handheld computing device); and an information collecting apparatus for collecting the electronic guide information which has been lent to the portable terminal

apparatus (Transmission system or kiosks), wherein, when the electronic guide information is collected at the exit, the electronic guide information is erased (C49, shopping assistance link deleted along with icon/descriptive information – once user out of range or has exited the facility), and at least one of information about use status of the customer attracting facility by the information user (C46 L9-42, Financial transaction information sent to user; C63 L13-20, download personal postcard) and advertisement information about the customer attracting facility is written in the portable terminal apparatus (C47-C48, targeted advertising; C51 L18-26, Advertisements received at checkout); and wherein the system performs processing such that the reading of the electronic guide information is permitted at the entrance, while the reading of the electronic guide information is inhibited at the exit (Reading of Guide information is within transmission range – which can be configured to be at entrance/exit to a facility, C23 L8-35).

12. As per Claim 6, Treyz discloses wherein, when the electronic guide information about the customers attracting facility is lent from the information lending apparatus (transmission system) to the portable terminal apparatus (Handheld computing device), the electronic guide information is encrypted beforehand at the time of being downloaded from the information lending apparatus to the portable terminal apparatus, and the electronic guide information is decrypted at the entrance (Data transmission security).
13. As per Claim 8, Treyz discloses wherein specific wireless broadcasting means effective in a target area is provided to the customers attracting facility, and wherein

the electronic guide information is provided to the portable terminal apparatus from the specific wireless broadcasting means.

14. As per Claim 9, Treyz discloses wherein the portable terminal apparatus comprises receiving means for receiving a wireless broadcasting signal from the specific wireless broadcasting means.
15. As per Claim 10, Treyz discloses wherein, when the portable terminal apparatus does not have the receiving means, the receiving means is lent at the entrance of the customers attracting facility.
16. As per Claim 11, Treyz discloses wherein the electronic guide information received by the receiving means is correlated with electronic guide information, which has been already stored in the portable terminal apparatus.
17. As per Claim 12, Treyz discloses wherein the portable terminal apparatus comprises position-measuring means for measuring latitude, longitude, and height by use of an artificial satellite, so as to specify the position of this portable terminal apparatus itself.
18. As per Claim 13, Treyz discloses wherein, when the portable terminal apparatus does not have the position measuring means, the position measuring means is lent at the entrance of the customers attracting facility.
19. As per Claim 14, Treyz discloses wherein the measurement information obtained by the position measuring means is correlated with map information about the customers attracting facility, which has been already stored in the portable terminal apparatus.

20. As per **independent Claim 15**, Treyz discloses an information distributing apparatus (Transmission system) for distributing guide information about a customers attracting facility to an information user, comprising: a data inserting section (data system - computer, Fig.13); and a transmitting section for transmitting (Fig.13, Transmitter – capable of transmitting a Videos transmitted a frequency to the handheld computing devices – coded and decoded through transmitter and receiver, C13 L46-47).
21. As for the limitations of the functions of the apparatus or what the apparatus does, i.e. “multiplexing the data strings into a vertical blanking interval of a television broadcast signal for transmission”, these carry no patentable weight in an apparatus claim. Apparatus claims should cover what a device is or structures or structural elements, not what a device does. See *Hewlett-Packard Co. vs. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990).
22. As per **independent Claim 19**, Treyz discloses a portable terminal apparatus for obtaining and processing electronic guide information about a customer attracting facility (Fig.13, Handheld computing device), comprising a manipulating section (Computer, Fig.13); a receiving section (Fig.13, Handheld computing device); a nonvolatile storing apparatus (Handheld computing device – memory; or system server); and a controlling apparatus (system server collects user information, C46).
23. As for the limitations of the functions of the **apparatus** or what the **apparatus** does, i.e. – “when the electronic guide information about the customers attracting facility is collected, erasing the electronic guide information,” these carry no patentable weight in an apparatus claim. Apparatus claims should cover what a device is or structures

or structural elements, not what a device does. See *Hewlett-Packard Co. vs. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990).

24. As for Dependent Claims 20-22 and 24-27, which further deal with other functions of the apparatus, they are rejected for the same reason set forth in Claim 19 above.
25. As per **independent Claim 28**, Treyz discloses a method for processing electronic guide information which electronically processes guide information about a customers attracting facility, the facility having one or more customer exits (inherent and lawfully required for all stores and amusement parks, Fig 10), comprising the steps of: producing electronic guide information at an information provider side based on the guide information (store computer, data configuration for transmission), and distributing the electronic guide information to a portable terminal apparatus carried by an information user (transmitting data, Fig.2, Fig.13); obtaining the distributed electronic guide information at the information user side (send and receive transmission); presenting the obtained electronic guide information to the information user (C1-C2); erasing the electronic guide information from the portable terminal apparatus at an exit from the facility (C49, shopping assistance link deleted along with icon/descriptive information – once user out of range or has exited the facility); and writing in the portable terminal apparatus at least one of information about use status of the customers attracting facility by the information user (C46 L9-42, Financial transaction information sent to user; C63 L13-20, download personal postcard) and advertisement information about the customers attracting facility (C47-C48, targeted advertising; C51 L18-26, advertisements received at checkout).

26. As per Claim 29, Treyz discloses wherein the electronic guide information is distributed to the portable terminal apparatus by use of an already-existing broadcasting infrastructure or/and a communication infrastructure.
27. As per Claim 30, Treyz discloses wherein the electronic guide information about the customers attracting facility is recorded in an information recording medium and is provided to an information user, and wherein, at the time of using the information recording medium, the information user mounts the information recording medium to the portable terminal apparatus (C35 L10-20, removable storage media).
28. As per Claim 31, Treyz discloses wherein the information-recording medium is provided by use of an already-existing sales infrastructure (C35 L10-20, store provides removable storage media).
29. As per **independent Claim 32**, Treyz discloses a method for processing electronic guide information which processes electronic guide information about a customers attracting facility which restricts the customers to go in and out only through its entrance and exit (common amusement park customer ticketing/access control, Treyz discloses ticketing elements), comprising the steps of: lending the electronic guide information at the entrance to a portable terminal apparatus carried by an information user (transmitting guide information – links, icon, C49); and erasing the lent electronic guide information at the exit from the portable terminal apparatus (C49, shopping assistance link deleted along with icon/descriptive information – once user out of range or has exited the facility); and writing in the portable terminal apparatus at least one of information about use status of the customers attracting facility by the

information user (C46 L9-42, Financial transaction information sent to user; C63 L13-20, download personal postcard) and advertisement information about the customers attracting facility (C47-C48, targeted advertising; C51 L18-26, advertisements received at checkout).

30. As per Claim 33, Treyz discloses wherein, when the electronic guide information about the customers attracting facility is lent, the electronic guide information is encrypted beforehand at the time of being downloaded, and the electronic guide information is decrypted at the entrance (Data transmission security).
31. As per Claim 35, Treyz discloses wherein specific wireless broadcasting means are effective only in a target area is provided to the customers attracting facility, and wherein the electronic guide information is provided to the portable terminal apparatus carried by information user from the specific wireless broadcasting means (transmission area).
32. As per Claim 36, Treyz discloses wherein, when the portable terminal apparatus does not have the receiving means, the receiving means is lent at the entrance of the customers attracting facility (C10 L3-6, shopping cart mounted devices).
33. As per Claim 37, Treyz discloses wherein the electronic guide information received by the receiving means is correlated with electronic guide information, which has been already stored in the portable terminal apparatus (C22, map data downloaded from kiosk correlated with transmitted guide data).
34. As per Claim 38, Treyz discloses wherein the portable terminal apparatus comprises position-measuring means for measuring latitude, longitude, and height by use of an

artificial satellite, so as to specify the position of this portable terminal apparatus itself (C23, GPS).

35. As per Claim 39, Treyz discloses wherein, when the portable terminal apparatus does not have the position measuring means, the position measuring means is lent at the entrance of the customers attracting facility (C10 L3-6, shopping cart mounted devices).
36. As per Claim 40, Treyz discloses wherein the measurement information obtained by the position measuring means is correlated with map information about the customers attracting facility, which has been already stored in the portable terminal apparatus (C22, map data downloaded from kiosk correlated with transmitted guide data).

Response to Arguments

37. Applicant's arguments filed 12/23/2005, with respect to Claims 1-6, 8-15, 19-22, 24-33, and 35-40, have been considered but are not persuasive. The rejection will remain as FINAL, based on the cited prior art.
38. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
39. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action

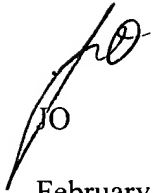
is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

40. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
41. Additional Literature has been referenced on the attached PTO-892 form, and the Examiner suggests the applicant review these documents before submitting any amendments.
42. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (571) 272-6807. The examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.
43. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone numbers for the organization where this application or proceeding is assigned (571) 273-8300 for all official communications.

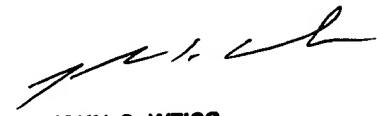
Art Unit: 3629

44. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Office of Initial Patent Examination whose telephone number is (703) 308-1202.



JO

February 27, 2006



JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600